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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,863	07/31/2003	Ronald D. House	112226	9069

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OLIFF & BERRIDGE, PLC.
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EXAMINER

MCLEAN, NEIL R

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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11/28/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27074@oliff.com
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Office Action Summary

Application No.

10/630,863

Applicant(s)

HOUSE ET AL.

Examiner

Neil R. McLean

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-6; 8-10, 12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-6; 8-10, 12 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/01/2007 has been entered.

Response to Amendment

2. Applicant's arguments with respect to claims 5-6, 8-10, 12 and 15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Wasilewski et al. (US 2002/0105665).

Regarding Claim 12:

Wasilewski et al. discloses a system for transferring a computer file from a portable digital storage media ([0027]; lines 1-10), the system comprising:

a media distribution device for distributing a storage media (Step 218 in Figure 5 describes the Kiosk dispensing media);

a portable digital storage media read/write interface for coupling the portable digital storage media to the media distribution device (The portion of the function described in [0060]; lines 7-13 which enables the read;/write interface; e.g., Multi-Card reader 116 in Figure 3);

a target selector (e.g., Touch Display Screen User Interface 102 in Figure 3; [0058]; lines 6-12) for selecting a remote target and transferring a computer image file from a network storage to the portable digital storage media to be dispersed at the remote target (The program code or device which performs the function described in [0060]; lines 7-13); and

a payment interface (ATM Kiosk 40 in Figure 2) for accepting payment for a transaction (Figure 6; [0057]; lines 15-25) in which the computer file is transferred from the portable digital storage media to the storage media,

wherein the storage media is paper and the media distribution device is one or more of a digital photocopier, CD-ROM, DVD-ROM and CD-RW ([0060]; lines 27-31) and the media distribution device is a digital image forming device (See Computer 16

and 58 in Figure 4;).

Regarding Claim 15:

Wasilewski et al. discloses the system of claim 12, further comprising:

a portable electronic device interface (e.g., Touch Display Screen User Interface 102; [0058]; lines 6-12), wherein the portable electronic device interface is in communication (See Communication Device 117 in Figure 3; [0058]; lines 26-31) with the portable digital storage media and wherein the portable digital storage media is controlled by a portable electronic device (e.g., Computer 112 in the Kiosk; [0058]; lines 22-26).

Claim Rejections - 35 USC § 103

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-6, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al. (US 2002/0105665) in view of Frey et al. (US 6,369,908).

Regarding Claim 5:

Wasilewski et al. discloses a method (The program code or device which performs the function described in [0027]; lines 1-10) of purchasing media from a digital image forming device (Kiosk 10 in Figure 1; [0056]; lines 5-9), comprising:

selecting a portable digital storage media type (The program code or device as described in [0056]; lines 17-20 which allows the user to make a selection);

selecting a portable digital storage media amount (Note: Wasilewski et al. mentions a plurality of goods and services; e.g., described on Page 6, Column 2, Claim 2; "at least one imaging service comprises the providing of image *goods and/or services*"; Wasilewski et al. provides a receipt for the processed transaction; [0057]; lines 23-25; It is inherent that this could include more than one storage media to be purchased at the kiosk.);

charging a transaction fee ([0059]; lines 1-5);

transferring a computer image file from a network storage (The program code or device which performs the function described in [0058]; lines 26-40);

dispensing the portable digital storage media (The program code or device which performs the function described in [0060]; lines 27-31); and

selecting a remote target (Step 202 in Figure 5) and transferring the computer image file from the network storage to the portable digital storage media (The program code or device which performs the function described in [0060]; lines 7-13), before the step of dispensing the portable digital storage media at the remote target (The program code or device which performs the function described in [0060]; lines 27-31).

Wasilewski et al. does not disclose expressly wherein the purchase includes the purchase of a portable digital storage media at the kiosk.

Frey et al. discloses wherein the purchase includes the purchase of a portable digital storage media at the kiosk (Column 3, lines 3-6).

Wasilewski et al. & Frey et al. are combinable because they are from the same field of endeavor of image processing, e.g., providing imaging products at a kiosk.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the sale of portable media storage devices as taught by Frey et al. in the photo kiosk of Wasilewski et al.

The suggestion/motivation for doing so would have been provide the user with the option to purchase the media storage device at the kiosk instead of having to provide their own.

Therefore, it would have been obvious to combine Frey et al.'s option to purchase the media storage device at the kiosk with Wasilewski et al. photo kiosk to obtain the invention as specified in claim 5.

Regarding Claim 6:

Wasilewski et al. further discloses the method of claim 5, wherein the portable digital storage media comprises one or more of CD-ROM, DVD-ROM and CD-RW ([0060]; lines 27-31).

Regarding Claim 8:

Wasilewski et al. discloses a system for purchasing media ([0027]; lines 1-10) from a digital image forming device (Kiosk 10 in Figure 1; [0056]; lines 5-9), the system comprising:

a payment interface ([0057], lines 15-25);

a media distribution device (Step 218 in Figure 5) for dispensing the portable digital storage media ([0060]; lines 27-31); and

a user input device (e.g., Touch Display Screen User Interface 102 in Figure 3; [0058]; lines 6-12) for selecting a remote target and transferring a computer image file from a network storage to the portable digital storage media to be dispersed at the remote target (The program code or device which performs the function described in [0060]; lines 7-13).

Wasilewski et al. does not disclose expressly wherein the purchase includes the purchase of a portable digital storage media at the kiosk.

Frey et al. discloses wherein the purchase includes the purchase of a portable digital storage media at the kiosk (Column 3, lines 3-6).

Wasilewski et al. & Frey et al. are combinable because they are from the same field of endeavor of image processing, e.g., providing imaging products at a kiosk.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the sale of portable media storage devices as taught by Frey et al. in the photo kiosk of Wasilewski et al.

The suggestion/motivation for doing so would have been provide the user with the option to purchase the media storage device at the kiosk instead of having to provide their own.

Therefore, it would have been obvious to combine Frey et al.'s option to purchase the media storage device at the kiosk with Wasilewski et al. photo kiosk to obtain the invention as specified in claim 8.

Regarding Claim 9:

Wasilewski et al. further discloses the system of claim 8, wherein the portable digital storage media comprises one or more of CD-ROM, DVD-ROM and CD-RW ([0058]; lines 17-22); and

wherein the media distribution device is a digital image forming device, and the portable digital storage media is one or more of CD-ROM, DVD-ROM and CD-RW ([0060]; lines 27-31).

Regarding Claim 10:

Wasilewski et al. further discloses the system of claim 8, wherein the digital image forming device is a digital photocopier (e.g., Printer 18 in Figure 1).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nihei (US 7,098,942) discloses an image capture system that captures image data that has been recorded on a portable recording medium and prints out the image represented by the captured image data. Image data can also be recorded on a portable recording medium.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is 571.

270.1679. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571.272.7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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11/20/2007

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SUPERVISORY PATENT EXAMINER